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EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1794

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10/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,261	Applicant(s) KORNFALT ET AL.	
	Examiner Brent T. O'Hern	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action as been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 August 2008 has been entered.

Claims

2. Claims 1-20 are pending.

WITHDRAWN REJECTIONS

3. All rejections of record in the Office Action mailed 1 May 2008, pages 3-12, paragraphs 6-13, have been withdrawn due to Applicant's amendments in the Paper filed 1 August 2008.

NEW REJECTIONS

Claim Rejections - 35 USC § 102

4. Claims 1-2, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Garu (WO 03/060256) with evidence by Garu (US 2005/0115181) and the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger"). Garu ('181) is interpreted as the English equivalent to Garu ('256). The paragraphs and figures of Garu ('181) are cited for Garu ('256).

Garu ('256) teaches a flooring system comprising a plurality of panels, at least one panel differing in at least one of aesthetic or mechanical properties from another panel of the system, each panel provided with edges, the edges being provided with a snap-joining functionality, the panels further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each panel is provided with an upper decorative surface with a surface structure and the flooring system comprises panels with at least two of the decorative surfaces of the flooring system being different and selected from the group consisting of a fabric or a mineral composite (See FIGs 2-3, 10-11, 1 and paras. 61-72, 81-84, as illustrated in FIG-2 and the other figures, module #1, with decorative lamina #6, receptacle for receiving lamina #59, lower web #14, square tile #7, glass #15 and decorative sheet #16. Fig-3 illustrates tiles #7bis with carpet #23. FIG-10 illustrates the panels being joined by male and female members #35 and #34, respectively having a snap-joining functionality. The surfaces of the panels are made of different materials. Claims 1 and 10 do not require the decoration on the upper surfaces of two panels to be different but rather the surface on one panel to be different from the surface on another panel which is always the case with two or more panels.).

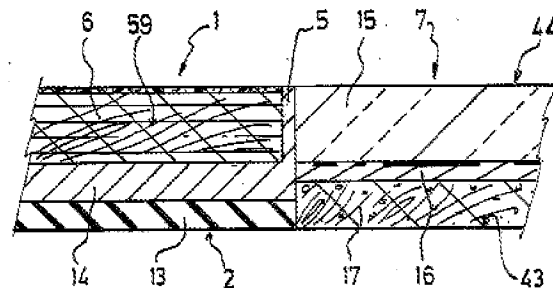


Fig 2

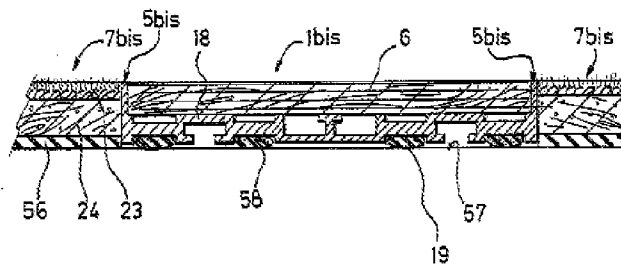


Fig 3

Fig 10

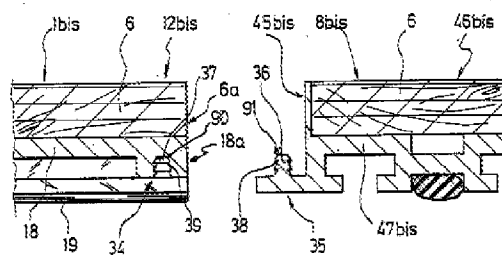
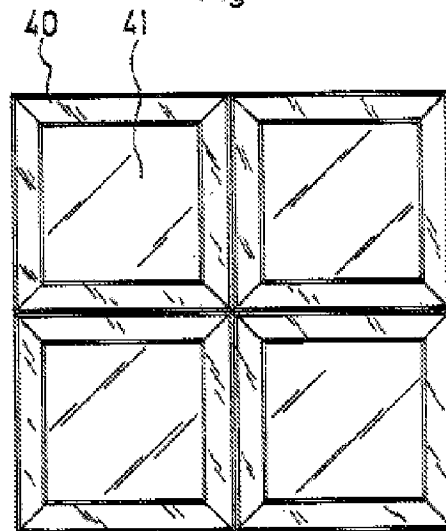
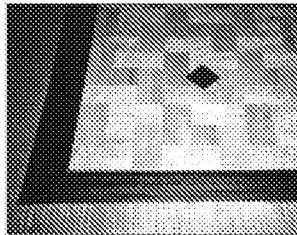
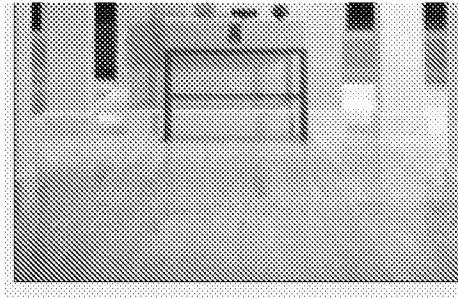


Fig 11

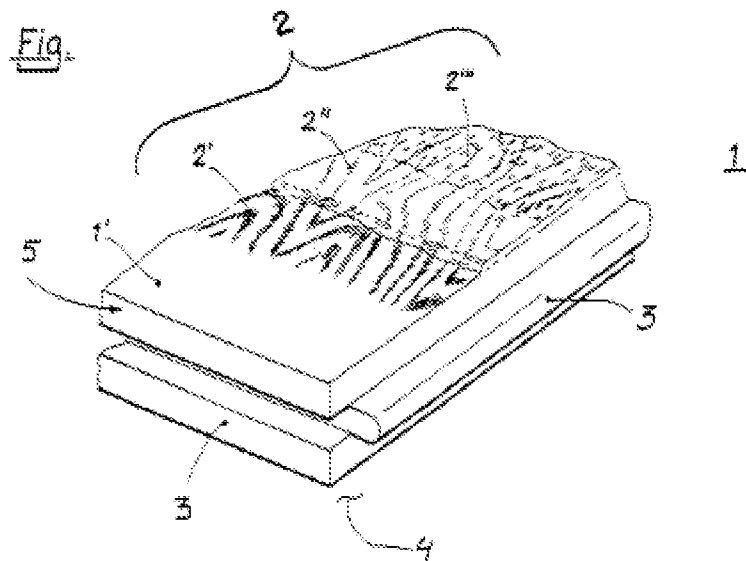


See as evidence pp. 49-55 including the figures on pages 49, 50 and 53 of Bollinger where combining various materials such as wood, metal, stones, etc. were known at the time of Applicant's invention. The above cited teachings of Bollinger are applicable for all of the below listed claims and combinations of references.



5. Claims 1, 4-6, 8-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (US 6,465,046) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

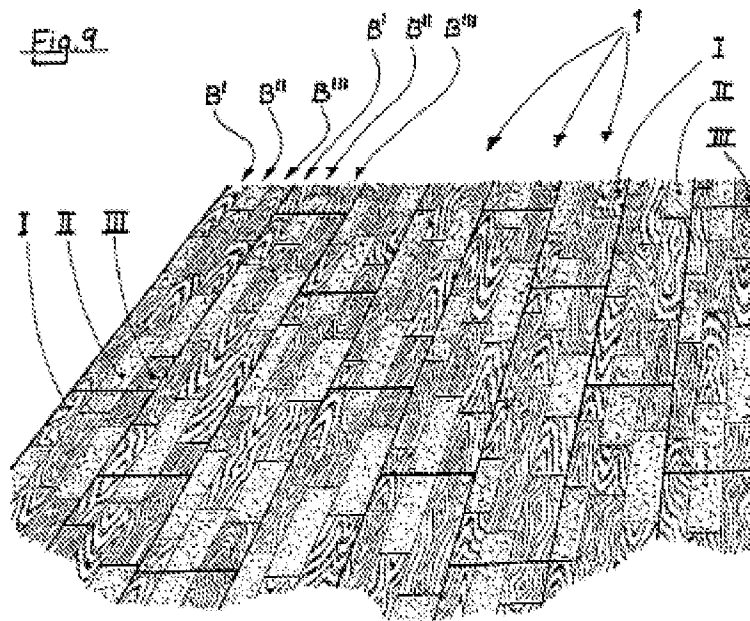
Hansson ('046) teaches a flooring system comprising a plurality of panels, at least one panel differing in aesthetic properties from another panel of the system, each carrying panel with edges (*See FIG-1, col. 6, l. 65 to col. 7, l. 11 and col. 10, ll. 15-28 where a decorative surface element such as a map extends over several panels, thus providing for different aesthetic properties on the different panels since each panel has a different portion of the map.*),

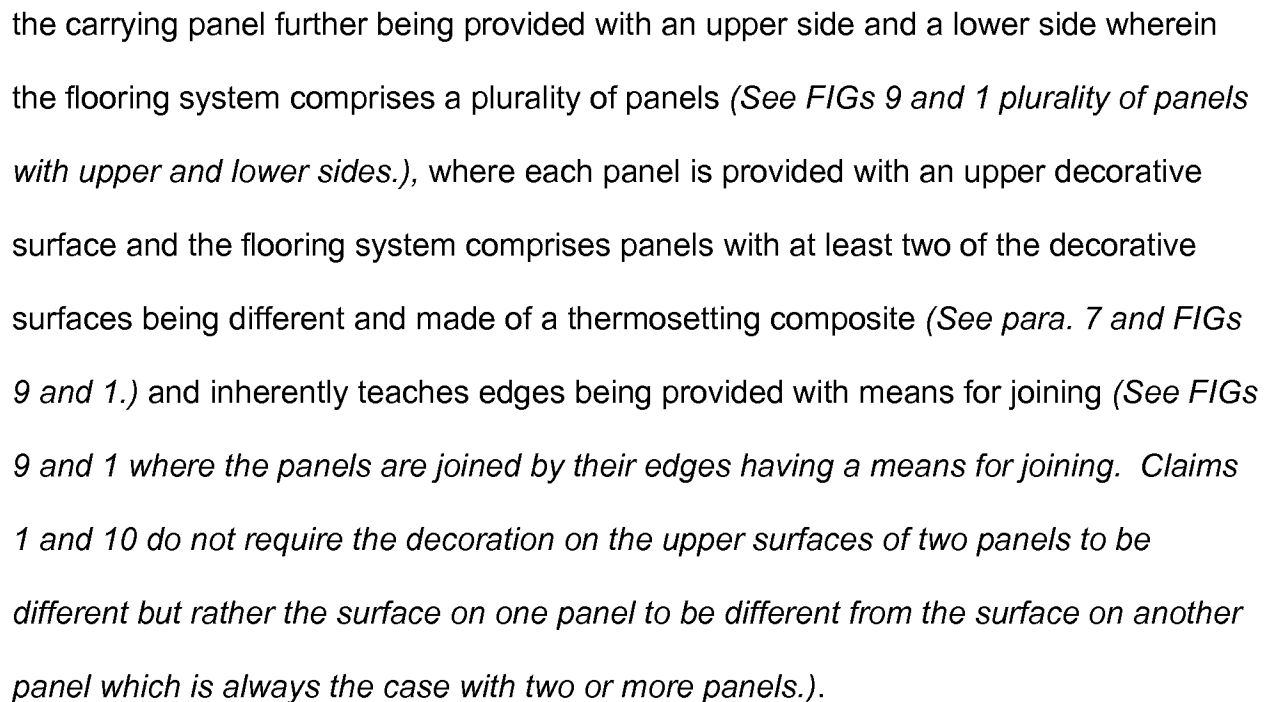


the edges being provided with means for joining (See FIG-1, entire FIG where the panel has tongues and grooves at the edges for joining the panels.), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (See FIG-1, panels having upper/lower sides.) where each panel is provided with an upper decorative surface and that the flooring system comprises panels being different with at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150 μm (See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2. Claims 1 and 10 do not require the decoration on the upper surfaces of two panels to be different but rather the surface on one panel to be different from the surface on another panel which is always the case with two or more panels.).

6. Claims 1, 10 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sjoberg (US 2004/0170812) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Sjoberg ('812) teaches a flooring system comprising a plurality of panels with surface structures, at least one panel differing in aesthetic properties from another panel of the system, each carrying panel with edges (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and II. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.),



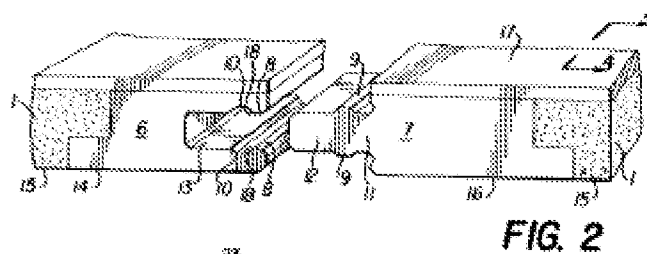


In the alternative, a person having ordinary skill in the art would obviously appreciate or provide a means for joining the panels. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

Claim Rejections - 35 USC § 103

7. Claims 1-3, 7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (US 6,397,547) in view of Sjoberg (US 2004/0170812) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as “Bollinger”).

Regarding claims 1 and 10, Martensson ('547) teaches a flooring system comprising a carrying panel with edges (See col. 3, ll. 31-42 and FIG-2, panel #1 with groove #6 and tongue #7.), the edges being provided with means for joining (See FIG-2, groove #10 and snapping web #9 for joining.), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (See FIG-2, panels #1 and col. 2, ll. 30-63.) where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil, (See col. 3, ll. 23-30 and FIG-2, #1.),



however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties and different from another panel of said system.

However, Sjoberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically and different from another panel of the system (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require the decoration on the upper surfaces of two panels to be different but rather the surface on one panel to be

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different from the surface on another panel which is always the case with two or more panels.) for the purpose of providing panels with the desired décor or pattern (See para. 3.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically and different from another panel as taught by Sjoberg ('812) in Martensson ('547) in order to provide panels with the desired décor or pattern.

Regarding claim 2, Martensson ('547) teaches where the edges are provided with snap-joining functionality (See FIG-2, groove #10 and snapping web #9.).

Regarding claim 3, Martensson ('547) teaches where the edges are provided with pre-applied glue (See col. 2, ll. 43-47 and col. 4, ll. 6-11.).

Regarding claim 7, Martensson ('547) teaches where the thermoplastic composite comprises thermoplastic materials selected from the group consisting of polyvinyl chloride, and polyethylene (See col. 3, ll. 23-27.).

Regarding claim 11, Martensson ('547) teaches where the thermoplastic foil is polyvinyl chloride, polyethylene or polypropylene (See col. 3, ll. 23-27.).

8. Claims 4-9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garu (WO 03/060256) with evidence by Garu (US 2005/0115181) and the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger") in view of Hansson et al. (US 6,465,046).

Garu ('256) teaches the flooring system discussed above, however, fails to expressly disclose at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminium oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150 μ m, thermoplastic materials such as PVC, polyolefins and other polymers, polymeric and metal foils.

However, Hansson ('046) teaches flooring panels where at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminum oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150 μ m (*See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2.*) for the purpose of providing a stable, strong, abrasion resistant decorative panel (*See col. 7, ll. 12-15 and Abstract.*). Furthermore, selecting one of the above polymeric or metal materials for the panel surfaces would have been obvious depending on whether the panels are used outdoors, indoors, subject to heavy traffic, no traffic, consumer preference based on appearance or cost.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide Garu's ('256) mixed flooring having panels with the above materials as taught by Hansson ('046) and the other polymeric/metal materials in order to provide a stable, strong, abrasion resistant decorative panel.

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9. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garu (WO 03/060256) with evidence by Garu (US 2005/0115181) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger") in view of Sjoberg et al. (WO 02/47906).

Garu ('256) teaches the flooring system discussed above, however, fails to expressly disclose panels wherein the elastomeric foil comprises thermoplastic elastomers.

However, as discussed above, Garu ('256) teaches its mixed flooring can be made of various materials based on user preference. Furthermore, Sjoberg ('906) flooring panels made of elastomeric foil which comprises thermoplastic elastomers (See *p. 2, ll. 15-22.*) for the purpose of providing a flooring panel that is resistant to abrasion, chemicals and sound (See *p. 1, ll. 1-7.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide Garu's ('256) flooring system with panels made of thermoplastic elastomers as taught by Sjoberg ('906) in order to provide panels that are resistant to sound, abrasion and chemicals.

The phrase "wherein the elastomeric foil is placed on panels wherein the panels are intended to be walkways while the rest of the floor has a high-gloss wood design of thermosetting composite" in claim 15, lines 9-11 is deemed to be a statement with regard to the **intended use** and is not further limiting in so far as the structure is concerned (see *MPEP 2111.02*). Sjoberg's ('906) panels are clearly cable of being

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used as such. Since the none of the surface is required to be a walkway no foil is required to be placed on the panels. Additionally, since none of the surface is required not to be a walkway then none of the high gloss design is required.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garu (WO 03/060256) with evidence by Garu (US 2005/0115181) and the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Garu ('256) teaches the panels discussed above made of carpet, however, fails to expressly disclose the carpet being a needle loom carpet.

However, a person having ordinary skill in the art at the time Applicant's invention was made would know that there are many different types of carpet, with people having different preferences, which are functionally equivalent to each other including loom carpet. Thus, it is a matter of design choice and personal preference to select one type of carpet over another. Furthermore, Applicant has not set forth any criticality of using one type of carpet over another. Therefore, it would have been obvious to substitute Garu's ('181) generic carpet by needle loom carpet in order to provide a carpet that is aesthetically pleasing to the user.

11. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Regarding claim 17, Sjoberg ('812) teaches the system discussed above, however, fails to expressly disclose where the fabric comprises a needle loom carpet.

However, Bettinger ('237) teaches that floor panels made of carpet and other materials such as vinyl are known (*See col. 4, ll. 33-61 and FIGS 4A, 10 and 1, panels #20. Furthermore, a needle loom carpet and Bettinger's ('237) carpet are interpreted as being interchangeable as Applicant has not presented any criticality of using one carpet over another.*) for the purpose of providing a flexible, resilient walking surface for an easily accessible, expandable flooring (*See col. 1, ll. 16-35.*). Furthermore, it was known at the time Applicant's invention was made that in office environments people have a preference for flooring surfaces that are carpeted in some regions and smooth in the immediate vicinity of the desk chair so as allow for easy movement of a desk chair, especially one that has rollers.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide floor panels with carpet as taught by Bettinger ('237) in Sjoberg ('812) in order to provide a flexible, resilient flooring that can easily be used in combination with other flooring materials.

Regarding claim 18, Sjoberg ('812) teaches a floor comprising a thermosetting composite (*See para. 7 and FIGs 9 and 1.*), however, fails to expressly disclose said materials being incorporated into the surface of the panels. However, it would it would have been obvious to incorporate said materials into the surface depending on how the flooring it used, whether the use is indoor, outdoor, high traffic, etc.

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12. Claims 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garu (WO 03/060256) with evidence by Garu (US 2005/0115181) and the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger") in view of Sjoberg et al. (WO 02/47906).

Garu ('256) teaches the panels discussed above, however, fails to expressly disclose the floor also comprising an elastomeric/thermoplastic foil or thermosetting materials.

However, Sjoberg ('906) teaches flooring comprising an elastomeric foil (*See p. 2, ll. 15-22.*) for the purpose of providing a floor with decreased sound production, especially when people walk on the floor with heels (*See p. 1, ll. 1-2 and 8-13.*).

Furthermore, the above materials are common materials used in flooring and it would have been obvious to use them based on where and how the floor is to be used, such as outdoors, indoors, heavy traffic areas, or in a way that is aesthetically pleasing to the user.

Therefore, it would have been obvious to a person having ordinary skill in the art to provide a flooring with an elastomeric foil as taught by Sjoberg ('906) and the other common flooring materials in Garu ('256) in order to provide quieter, pleasing floors.

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Martensson (US 6,397,547) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

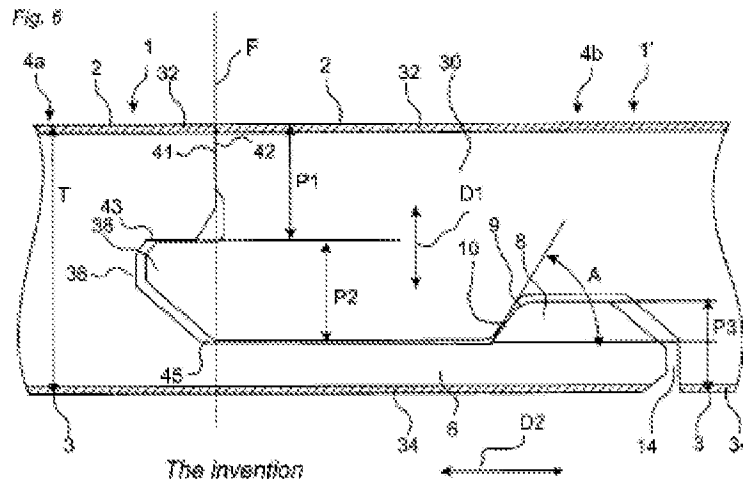
Sjoberg ('812) and Bettinger ('237) teach the system discussed above, however, fail to expressly disclose where the floor comprises a thermoplastic foil.

However, Martensson ('547) teaches a flooring comprising a thermoplastic foil (*See col. 3, ll. 23-27.*) for the purpose of providing a flooring that does not absorb water (*See col.3, ll. 28-30.*).

Therefore, it would have been obvious to provide a flooring made of thermoplastic foil as taught by Martensson ('547) in Sjoberg ('812) in order to provide a flooring that does not absorb water.

14. Claims 1, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pervan (US 2002/0007609) in view of Sjoberg (US 2004/0170812) with evidence by the publication by Don Bollinger, *Mixing It Up*, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Regarding claims 1 and 10, Pervan ('609) teaches a flooring system comprising a carrying panel with edges (*See para. 62 and FIG-6, panels #1 and #1'.*), the edges being provided with means for joining (*See para. 62 and FIG-6, wherein panels #1 and #1' are joined by tongues #38 and grooves #36.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See para. 62 and FIG-6, panels #1 with upper/lower sides.*), where each panel is provided with an upper decorative surface are a metal sheet (*See paras. 9 and 62 and FIG-6, panels #1 and #1'.*),



however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties and different from another panel of said system.

However, Sjöberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically from another panel of the system (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances and different. Claims 1 and 10 do not require the decoration on the upper surfaces of two panels to be different but rather the surface on one panel to be different from the surface on another panel which is always the case with two or more panels.) for the purpose of providing panels with the desired décor or pattern (See para. 3.).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically and

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different from another panel as taught by Sjoberg ('812) in Pervan ('609) in order to provide panels with the desired décor or pattern.

Regarding claim 12, Pervan ('609) teaches wherein the metal sheet is aluminum foil (*See para. 9.*).

15. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of Sjoberg (US 2004/0170812) with evidence by the publication by Don Bollinger, *Mixing It Up*, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Sjoberg ('906) teaches a flooring system comprising a carrying panel with edges (*See p. 1, ll. 16-25 floor laminate with edges.*), the edges being provided with means for joining (*See p. 1, ll. 16-25 wherein the panel clearly has edges and all edges can clearly be joined.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See p. 1, ll. 16-25 wherein the plurality of panels have upper/lower sides.*), where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil and different (*See p. 2, ll. 15-22.*), however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system.

However, Sjoberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically from another panel of the system (*See FIGs 9 and 1 where the panels with edges have different aesthetic appearances*

due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances. Claims 1 and 10 do not require the decoration on the upper surfaces of two panels to be different but rather the surface on one panel to be different from the surface on another panel which is always the case with two or more panels.) for the purpose of providing panels with the desired décor or pattern (See para. 3).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically from another panel as taught by Sjoberg ('812) in Sjoberg ('906) in order to provide panels with the desired décor or pattern.

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Sjoberg et al. (WO 02/47906) with evidence by the publication by Don Bollinger, Mixing It Up, August/September 2003, *Hardwood Floors*, pp. 49-55 (herein after referred to as "Bollinger").

Sjoberg ('812) and Bettinger ('237) teach the system discussed above, however, fails to expressly disclose where the floor also comprises an elastomeric foil.

However, Sjoberg ('906) teaches flooring comprising an elastomeric foil (See p. 2, *ll.* 15-22.) for the purpose of providing a floor with decreased sound production, especially when people walk on the floor with heels (See p. 1, *ll.* 1-2 and 8-13.).

Therefore, it would have been obvious to a person having ordinary skill in the art to provide a flooring with an elastomeric foil as taught by Sjoberg ('906) in Sjoberg ('812) in order to provide quieter floors.

ANSWERS TO APPLICANT'S ARGUMENTS

17. In response to Applicant's arguments (*pp. 6-11 of Applicant's Paper filed 1 August 2008*) that the cited references do not teach two panels having surfaces made of different materials, it is noted that that Applicant's arguments are not commensurate in scope with the claims as this is not what Applicant is claiming in independent claims 1 and 10 and the respective dependent claims. The claims require the surfaces of two panels to be different, however, do not require the materials of the two panels to be different. All panels have surfaces that are different from other surfaces. The Examiner acknowledges that newly created independent claims 14 and 15 claim such and the Specification at the beginning of page #1 discloses such, however, it is improper to read limitations into the above claims that are not set forth in the claims. Furthermore, as discussed above, the newly cited Garu ('256) reference teaches mixed combinations of panel surfaces.

18. In response to Applicant's arguments (*p. 7, para. 6 to p. 8, para. 2 of Applicant's Paper filed 1 August 2008*) that Sjoberg's (US 2004/0170812) a panel with 4 boards is identical to a board with 5 boards, it is noted that said argument does not make sense unless 4 equals 5, which is not the case.

19. In response to Applicant's arguments (*p. 8, para. 3 to p. 9, para. 1 of Applicant's Paper filed 1 August 2008*) regarding the thermosetting teaching of Sjoberg's ('906), it is

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noted that said arguments are persuasive and the previous combinations of teachings are no longer cited.

20. In response to Applicant's arguments (*p. 9, para. 2 of Applicant's Paper filed 1 August 2008*) regarding the foil and wood design, it is noted that Sjoberg's ('906) panels are clearly capable of being used as such. Furthermore, since none of the surface is required to be a walkway then no foil is required to be placed on the panels. Additionally, since none of the surface is required not to be a walkway then none of the high gloss design is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Brent T O'Hern/
Examiner, Art Unit 1794
September 17, 2008

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794